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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,091	04/09/2001	Paul J. Rankin	PHGB 000049	1787

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EXAMINER	
JEAN, FRANTZ B	

ART UNIT	PAPER NUMBER
2151	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,091	RANKIN ET AL.	
	Examiner	Art Unit	
	Frantz B. Jean	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 November 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This office action is in response to the amendment filed on 11/08/04. Claims 1-20 are pending in this application. Claims 12-20 have been added by the amendment filed on 11/08/04.

Drawings

The drawings were received on 11/08/04. These drawings are placed in the file.

Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,5, 8, 9, 11, 12, 13, 16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9 recite the limitation "associated user" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 1 and 9 recite the limitation "said terminal" in line 11; and "the terminal" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "said terminal". There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the user". There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the associated user" and "the associated user information" (see line 7). There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "said terminal" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the second network" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "said second network". There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the terminal". There is insufficient antecedent basis for this limitation in the claim.

Claims 11 and 20 recite the limitation "said beacons". There is insufficient antecedent basis for this limitation in the claim.

Claims 11 and 20 recite the limitation "when it is in range" and "within range". These limitations are vague and indefinite. Applicants must specify the range they are referring to.

Claim Objections

Claims 1 and 9 are objected to because of the following informalities: "comminations" in line 13 must be substituted by –communications--. Appropriate correction is required.

Claim 20 is objected to because of the following informalities: "an respective" must be substituted by –a respective item of said additional data--. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 9 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 15 of U.S. Patent No. 6,778,826. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are arguably broader than the claims of patent No. 6,778,826, which encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

Claims 1, 9 and 12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending Application No. 09/833,471. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims are arguably broader than the claims of copending application No. 09/833,471, which

encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC§ 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Amin (European Pub. No. EP 0888025A2)for the reasons stated in the PCT International Search Report for International Application No. PCT/EP01/04026.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(x) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described us set North in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis (Intl. Pub. No. WO 99133293)in view of Bunney et al. (European Pub. No. EP 0944002A1).
As to claim 1, Dennis teaches a networked communications apparatus comprising at least one server and a plurality of user stations, wherein the user stations comprise terminals which can receive information from the at least one server by means of a connection via a first network [pg. 7, lines 11 -20; Dennis discloses that users terminals access information on a personal profile server via the Internet (first network)], the apparatus further comprising": storage means holding a profile database, which profile database contains data representing a characteristic behavior of an associated user terminal [jig. 7,

lines 14-20; Dennis discloses that personal profiles arc stored on the personal profile server];
wherein the user station further comprises a portable communications device coupled with said terminal [Fig. 1; Dennis discloses a terminal connected to a wireless device via the internet and a wireless network; pg. 8, lines 18-20; Dennis discloses a terminal connected directly to a wireless network] and connectable to said at least one server via a second network [Fig. 1; pg. 7, line 21; Dennis discloses a wireless device coupled to an internet personal profile server via a wireless network (second network)], wherein the coupling with said terminal is by wireless transmission therefrom, and the portable communications device means for receiving wireless transmissions from the terminal are further configured to receive additional data transmitted wirelessly from other sources than said second network [pg_ 14, line 28 - pg. 15, line 6; Dennis discloses that the wireless device can receive information directly from other networks, e.g. a banking network].
Dennis does not expressly teach the limitation of storing data representing a characteristic behavior of an associated user terminal network address or addresses, the data being acquired automatically in response to an activity of the associated user and being stored together with the associated user terminal network address or addresses in the profile database.
However, Bunney teaches a method and system for retrieving information for a user based on an automatically created user profile. Bunney teaches the limitation of storing data representing a characteristic behavior of an associated user terminal network address or addresses, the data being acquired automatically in response to an activity of the associated user and being stored together with the associated user terminal network address or addresses in the profile database [par. 0007].
Dennis and Bunney are analogous art because they relate to information delivery based on user profiles.
It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dennis in view of Bunney so as to automatically create the user profile based on user activity. One would be motivated to do so since the creation of a profile by the user is cumbersome work [Bunney; par. 0003].

As to claim 2, the combination of Dennis in view of Bunney teaches the apparatus as claimed in claim 1, wherein said portable communications device comprises a mobile telephone [Dennis; pg. 7, lines 17-18] and said second network is a telecommunications network [Dennis", pg. 7, lines 22-24; wireless network as second network].

As to claim 3, the combination of Dennis in view of Bunney teaches the apparatus as claimed in claim 1, wherein the first network is the Internet and the user terminals comprise at east a display device coupled with processor means hosting an Internet browser and user-operable means for control of the same [Dennis; pg. 7, lines 3-4].

As to claim 4, the combination of Dennis in view of Bunney teaches the apparatus as claimed in claim 1, wherein said wireless transmission of additional data conforms to a predetermined set of communications protocols [pg. 14, line 28 - pg. 15, line G; Dennis discloses that the wireless device can receive information directly from other networks].

As to claim 5, the combination of Dennis in view o1 Bunney teaches a portable communications device for use in the apparatus of claim 1 and having means for

receiving wireless transmissions from said terminal [Fig. 1; Dennis discloses a terminal coupled to a wireless device via the internet and a wireless network; pg. 8, lines 18-20; Dennis discloses a terminal connected directly to the wireless network for a wireless device].

Claim 9 represents a method claim that corresponds; to apparatus claim 1. It does not teach or define any new limitations above claim I, and therefore is rejected for similar reasons.

As to claim 11, the combination of Dennis in view of Bunney teaches a method as claimed in claim 9, further comprising the provision of a plurality of short range beacons distributed about a geographical location, with each of said beacons transmitting a respective item of said additional data to the or each portable communications device when it is in rage [Dennis; pg. 8, lines 21-28; pg. 9, lines 9-11].

Claims 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennis in view of Burmey et al., and further in view of Martin, Jr. et al. (U.S. Pub. No. 2002/0122061).

As to claim 6, the combination of Dennis in view of` Bunney teaches the invention substantially as claimed (see rejection of claim 5 above).
The combination does not expressly teach the limitation of a portable communication device further comprising a buffer arranged to receive and store said additional data transmitted wirelessly.
However Martin teaches a method for configuring the display of a mobile device based on factors such as user preferences (par. 0045). Martin teaches the limitation of a portable communication device comprising a buffer arranged to receive and store data transmitted wirelessly [par. 0051; Martin discloses that the mobile device comprises a RAM for storing received data].
Dennis in view of Bunney and Martin are analogous art because they relate to customization of information for wireless devices.
It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dennis in view of Bunney, in view of Martin so as to allow the wireless device to store received information. One would be motivated to do so to enable the storage of downloaded configuration information on the wireless device [Martin; par- 004].
As to claim 7, the combination of Dennis in view of Bunney, in view of Martin teaches the portable communications device as claimed in claim 6, further comprising a clock signal source and being arranged to stamp items of received additional data with the time of receipt [pg. 4, lines 13-17; Dennis discloses maintaining a record of wireless transactions].
As to claim 8, the combination of Dennis in view o f Bunney, in view of Martin teaches the portable communications device as claimed in claim 5, further comprising user-operable data input means by operation of which the user is enabled to annotate or alter items of received additional data [pg. 4, lines 13-17; Dennis discloses that the user manages (alters) information received by the wireless device].

As to claim 10, the combination of Dennis in view of Bunney, in view of Martin teaches the method as claimed in claim 9, wherein the first network is the Internet [pa. 7, lines 1 1-20; Dennis discloses that users terminals access information on a personal profile server via the internet (first network)] and the received additional data comprises one or more uniform Resource Locators

[pg. 6, col. 1, lines 2-6; Martin discloses that the mobile device receives URLs].

As stated by applicants on page 8 paragraph 2 of the remarks, claims 12-20 are similar in scope as claims 1-11. Furthermore, it must be noted that claims 12-20 are a method that is carried out by the apparatus of claims 1-11. Therefore, they are rejected under the same rationale.

Response to Arguments

Applicant's arguments filed 11/08/05 have been fully considered but they are not persuasive.

Applicants argued that Amin does not teach a profile database that contains data representative of a characteristic behavior of an associated user terminal or network.

Examiner respectfully submits that Amin is directed to a method and apparatus that provides partitioned telecommunication service. Amin discloses a resource that may be a subscriber profile database such that multiple service providers maintain separate subscriber profile databases connected to a switch. The switch, upon determining the service provider associated with a subscriber requesting service, will retrieve the subscriber profile from the subscriber database associated with the identified service provider (see Amin's abstract, summary of invention, fig 2). Examiner believes that Amin discloses a profile database that contains data representative of a characteristic behavior of an associated user terminal or network (see reference indicated above).

Applicants argued that the claim as amended render the rejection moot. Therefore, Dennis in combination with Bunney and Martin fails to teach a first and a second network with the wireless device communicating via the second network.

In response, Examiner submits that Denis alone teaches a first (see ref fig 1, elements 101, 11 and 102) and a second network (see ref fig 1, elements 106,103 and 12), wherein the wireless device communicating via the second network and the second network is different from the first network. It is clear in Dennis that the first network is independent from the second network as shown in fig 1 (see also abstract and summary of the invention). Accordingly, the rejection is maintained.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571 272 3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean

FRANTZ B. JEAN
PRIMARY EXAMINER